

### **REMARKS/ARGUMENTS**

Applicants have fully considered the Office Action mailed August 19, 2005. Applicants request reconsideration of the application, withdrawal of the rejections, and issuance of a Notice of Allowance.

In the Office Action, the Examiner rejected pending claims 1-5 and 7-40. Applicants cancel claims 8, 9, and 39 herein. Applicants add new claims 41-47. Claims 1-5, 7, 10-38, and 40-47 are now pending.

Applicants have clarified the specification. Page 1, line 13 has been clarified as suggested by the Examiner in the Office Action. Applicants also clarify the specification to discuss that the compatibilizer may possess certain properties or features. Specifically, Applicants have clarified the specification to include a discussion that the compatibilizer may possess one or more of a certain softening point, glass transition temperature, weight average molecular weight, number average molecular weight, and/or dispersity. This discussion reflects various ranges for these properties. Applicants submit that the discussion of these properties does not constitute new matter as the material that has been added to the specification was present in the originally filed claims.

The Examiner rejected claims 1-5, 7-25, and 31-40 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,972,547 to Yaguchi et al. Applicants traverse this rejection.

The present claims generally recite a toner that includes a resin, colorant, wax, and a compatibilizer that is generated from a styrene monomer and an indene monomer. In another rejection, the Examiner notes that the Yaguchi reference fails to teach a toner composition that comprises wax. Therefore, Yaguchi fails to teach every element or feature of the present claims. A claim cannot be obvious in view of the prior art if the prior art fails to teach each and every element or feature of the claim. M.P.E.P. § 2143.03 (8<sup>th</sup> Ed.). Because Yaguchi fails to teach all the features of the present claims, it fails to render the claims obvious. Applicants request that the rejection of the claims in view of Yaguchi be withdrawn.

The Examiner objected to claims 26-30 under 35 U.S.C. § 103(a) as being unpatentable over Yaguchi in view of U.S. Patent No. 6,475,690 to Anno et al. The Examiner relies on the Anno reference for teaching the use of wax as a release agent for toners. Applicants traverse this rejection.

Despite Anno's teaching the use of wax as a release agent for toners, combination of Yaguchi and Anno fail to render the claims obvious. Claims 26-30 are dependent from claim 1. Claim 1 is clarified herein to indicate that the compatibilizer possess a softening point of from about 80°C to about 100°C. Neither Yaguchi nor Anno teach the use of a compatibilizer that is generated from a styrene monomer and an indene monomer that possesses a softening point of from about 80°C to about 100°C. Therefore the combination of Yaguchi and Anno fail to teach every feature of the claim and fail to render the claims obvious.

Applicants request that the rejections based on the combination of Yaguchi and Anno be withdrawn.

The Examiner rejected claims 9, 11, 34, 35, and 38 under 35 U.S.C. § 112 as being indefinite for not clearly setting forth the metes and bounds of the patent protection desired. Specifically, the Examiner objected to the claims for reciting a broad range and overlapping narrower ranges of various properties recited in the claims. Applicants traverse this rejection.


Claims 11, 34, 35, and 38 are clarified herein to recite one particular range and delete the other ranges recited in that specific claim. The narrower ranges recited in those claims are presented in new claims 41-47. Applicants note that claim 9 is canceled herein. Applicants submit that the clarifications remedy the Examiner's concerns and request that the rejection be withdrawn.

**CONCLUSION**

In view of the foregoing, Applicants submit that claims pending in the application (claims 1-5, 7, 10-38, and 40-47) are in condition for allowance. Applicants request that the rejections be withdrawn and that a Notice of Allowance be issued.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he is hereby authorized to call Richard M. Klein, at telephone number 216-861-5582, Cleveland, OH.

Respectfully submitted,  
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